

O I P DOCKET NO: 201339US90

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

ICHIRO OKAJIMA, ET AL.

: EXAMINER: ENG, G.

SERIAL NO: 09/745,546

: GROUP ART UNIT: 2643

RCE FILED: MAY 12, 2004

FOR: VIRTUAL TERMINAL
CONFIGURING METHOD AND DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

I am the attorney of record or acting under 37 C.F.R. § 1.34.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
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SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A *PRIMA FACIE* CASE OF OBVIOUSNESS

Applicants submit that the Official Action of March 11, 2005 (as well as previous actions such as August 9, 2004 and December 17, 2003) fails to provide a *prima facie* case of obviousness with respect to each of the pending Claims 5-8 and 18-35. The undersigned also notes that the Advisory Action of July 8, 2005, which further explains the rationale for rejecting the claims, maintains the assertion that Sugiyama (U.S. Patent No. 5,392,284) "is enough to teach the broad claimed limitations". Applicants respectfully disagree.

Each of pending claims stands rejected over Sugiyama in view of Bruno et al. (U.S. Patent No. 6,356,533, hereinafter "Bruno") and in the case of Claim 33, the tertiary reference of Lu (U.S. Patent No. 6,100,918). However, as outlined in detail in the response filed June 13, 2005, the rejection of these claims as specified by the Office does not present a

prima facie case of obviousness because the combination of Sugiyama in view of Bruno does not disclose the “terminal management unit” (see e.g. Claim 18) as claimed in the independent claims.

Claim 18 is directed to an apparatus that configures a “virtual terminal” (i.e. a set of devices that cooperate with one another to act as a terminal) by using a terminal management unit. The terminal management unit identifies communication attributes of communication devices accessible to it, and then determines which of the plurality of devices are capable of processing information of a first content part and a second content part of a calling signal. Thus, apparatus separates the parts of a calling signal, determines which communication devices can handle respective parts of the calling signal so the several devices cooperate with one another as a virtual terminal.

As explained in the top paragraph of page 10 of the response filed June 13, 2005, the invention allows a calling terminal to call any of a number of destination terminals, but have the terminal management unit intervene and assemble a “virtual terminal” capable of supporting all the functions and attributes of the calling signal. The second paragraph at page 10 of the same response provides an example of how a calling signal may include audio and video portions, and the terminal management unit identifies a first device to handle the audio portion of the calling signal, and a second device to handle the video portion of the calling signal. Once again, the calling terminal is unaware that it is communicating with several devices, nor does the calling terminal core because it does not have to adapt its functionality in anyway.

The outstanding Office Action at page 3, last three lines, recognizes that Sugiyama does not teach the terminal management unit as claimed. The Office Action however fails to mention that there are other aspects of Sugiyama that do not teach or suggest how the terminal management unit would interconnect and interoperate with other claimed features,

such as the information separating unit and virtual terminal interface. See the remarks and response at page 11, middle paragraph where it is pointed out that Sugiyama, to the extent it does disclose an information separating unit, requires that the first and second parts of the calling signal be sent to a destination terminal that is able to handle both the first and the second content parts, which is a feature fundamentally different than the claimed invention.

The Office Action asserts that Bruno cures the deficiency with regard to Sugiyama's failure to disclose a terminal management unit. The Office Action relies on Bruno's description of a CRAPS processor that receives profile information from a database and then sends "boot signals" to user devices instructing them how to change their appropriate communications mode. However the CRAPS processor in Bruno does not perform the function of the terminal management unit in that it does not identify communication attributes of the plurality of communication devices and identify which of the plurality of devices are capable of processing information corresponding to at least one of the first content part and the second content part of the calling signal. Applicants' invention allows for the calling terminal to merely provide a calling signal having certain attributes without any concern for the capabilities of the destination terminal(s) that will receive the calling signal. In contrast, Bruno requires the reception of a calling signal and then the sending of boot signals to the source and destination terminals to make the two devices cooperate in future communications using a common communication protocol. Thus, in Bruno the CRAPS processor is configured to change the operation of both the source and destination terminal to provide a common communication protocol between the two. However the invention of Claim 18 requires no modification at all to the calling terminal, but rather shifts the burden to the terminal management unit to identify and configure devices able to adequately process different content parts of the calling signal without the calling terminal even knowing that multiple devices are being used to process the calling signal.

In summary, Claim 18, for example, defines a terminal management unit and its cooperation between an information separating unit and virtual terminal interface, and the asserted prior art of Sugiyama and Bruno neither teach nor suggest the terminal management unit nor an equivalent device that would perform a corresponding function to provide interoperability with an information separating unit and virtual terminal interface as claimed. Accordingly, because the asserted prior art does not disclose all the elements of the claimed invention, it is respectfully submitted that the Office has not made a *prima facie* case of obviousness with regard to Claim 18. Likewise, the rejection of each of the other pending claims is also believed to be equally deficient.

CONCLUSION

Based on the legal deficiency in the above-noted rejection, Applicants request the withdrawal of the rejection of each of the pending claims.

Respectfully submitted,

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